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| 10/671,818 | 09/25/2003 | Tetsuya Kubo | 36081 | 6904 |

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EXAMINER

HAROON, ADEEL

ART UNIT PAPER NUMBER

2618

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,818

Applicant(s)

KUBO ET AL.

Examiner

Adeel Haroon

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to Amendment filed on date: 5/11/06.

Claims 1-19 are still pending.

Response to Arguments

2. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant's arguments filed 5/11/06 about claims 10-19 have been fully considered but they are not persuasive.

The applicant argues that the limitation "wherein, when the second housing is opened toward the first housing by turning the second housing around the hinge section, a side edge of the second housing, which is closer to the hinge section, is protruded from an outer surface of the first housing" is not disclosed by the cited prior art. The examiner respectfully disagrees.

Firstly, the limitation states, "when the second housing is opened toward the first housing". The wording of "opening toward" makes it unclear if the portable terminal is closed or open since the housings are moved towards each

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other in a closed state and the housings are opened away from each other in an opened state. Consequently, this limitation can be interpreted as being in a closed or open state.

Secondly, the limitation states, "a side edge of the second housing, which is closer to the hinge section". The word "closer" performs a comparative function but the limitation does not provide a reference for this comparison. Therefore, since it is unclear which side edge of the second housing is being claimed, the limitation can be interpreted as any side edge of the second housing.

Thirdly, the limitation is a conditional statement describing only one condition, either closed or open as explained above, of the two possible conditions.

Accordingly, a 35 USC 112 rejection is made below on all claims containing this limitation because of the indefiniteness caused by the claim language and applicant's arguments.

The applicant further argues that Constein does not fully anticipate claim 17. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "The dent in the claimed invention is formed on an inner surface to help users to easily open the first and second housings. This dent is especially helpful for users when the upper and lower housings are substantially equal in size or a spring for self-closing, for example, is incorporated into the hinge section") are not recited in the rejected claims. Although the claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10, 16, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims contain the limitation “wherein, when the second housing is opened toward the first housing by turning the second housing around the hinge section, a side edge of the second housing, which is closer to the hinge section, is protruded from an outer surface of the first housing”. The claim wording “when the second housing is opened toward the first housing” and “a side edge of the second housing, which is closer to the hinge section” make the claims unclear and thus indefinite as described above.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 10-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Tyneski et al. (U.S. 5,584,054).

With respect to claim 10, Tyneski et al. disclose a portable information terminal device in figure 2. Tyneski et al. disclose a first housing, element number 102, and a second housing, element number 104, coupled to the first housing in an openable and closeable fashion (Column 2, lines 8-27). As shown in figure 2, the second housing is smaller than the first housing. Tyneski et al. disclose “wherein, when the second housing is opened toward the first housing by turning the second housing around the hinge section, a side edge of the second housing, which is closer to the hinge section, is protruded from an outer surface of the first housing” as best interpreted by the examiner in figures 1 and 2.

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With respect to claim 11, Tyneski et al. shows that the length of one of the sides of the second housing is shorter than a length of corresponding side of the first housing as shown in figure 2.

With respect to claim 12, Tyneski et al. teaches hinge, element number 106, with a first hinge part, the part with ridges in figure 2, which forms one part of the hinge section is provided on a side edge part of the long side of the first housing, and a length of the long side of the second housing on which a second hinge part, the end pieces of the hinge, forming the other part of the hinge section is provided is shorter than a length of the long side of the first housing on which the first hinge part is provided (Column 1, lines 45-47).

With respect to claim 13, Tyneski et al. shows a mouthpiece, the unnumbered element at the bottom left of figure 1, which is inherently for detecting a sound is provided in an area on the inner surface of the first housing opposed to the second housing, the area being exposed to outside when the second housing is closed.

With respect to claim 15, Tyneski et al. shows that the short side of the second housing is a vertical side, and the lower side of the second housing is lacking in figures 1 and 2.

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8. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Constien (U.S. 6,259,932).

With respect to claim 16, Constien discloses a portable information terminal device (Abstract). Constien discloses a first housing, element number 2, and a second housing, element number 1, and a hinge section, element number 8, that connects the two housings (Column 6, lines 7-21). Constien also discloses that the first housing is coupled to the second housing in an openable and closeable fashion by the hinge section, and a first function operable when the first housing and the second housing are in an opened state and a second function operable when the first housing and the second housing are in a closed state is selectively used (Column 6, lines 7-21). Constien further discloses first operation section for a function as an information terminal is provided in an inner surface of the first housing and a second operation section for the function as a phone (Column 6, lines 36-65). Constien's portable information terminal includes

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a first display section 13 for both a function as a phone and the function as an information terminal is provided in an inner surface of the second housing (Column 6, lines 28-35). Constien's portable information terminal also includes a second display 4 for the function as a phone in an outer surface of the second housing (Column 6, lines 7-21). Constien discloses "wherein, when the second housing is opened toward the first housing by turning the second housing around the hinge section, a side edge of the second housing, which is closer to the hinge section, is protruded from an outer surface of the first housing" as best interpreted by the examiner in figures 1 and 2.

With respect to claim 17, Constien discloses a portable information terminal device (Abstract). Constien discloses a first housing, element number 2, and a second housing, element number 1, and a hinge section, element number 8, that connects the two housings (Column 6, lines 7-21). Constien also discloses that the first housing is coupled to the second housing in an openable and closeable fashion by the hinge section, and a first function operable when the first housing and the second housing are in an opened state and a second function operable when the first housing and the second housing are in a closed state is selectively used (Column 6, lines 7-21). Constien shows the keyboard, element number 14, as dent on an inner surface of the first housing, which is the first operation section for a function as an information terminal (Column 6, lines 24-27 and Column 6, lines 28-35). Constien also shows that both of an inner surface and an outer surface of the second housing almost commensurate an area

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of the dent of the first housing in figures 1 and 2. Constien's portable information terminal includes a first display section 13 for both a function as a phone and the function as an information terminal is provided in an inner surface of the second housing (Column 6, lines 28-35). Constien's portable information terminal also includes a second display 4 for the function as a phone in an outer surface of the second housing (Column 6, lines 7-21).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Constien (U.S. 6,259,932) in view of Novin et al. (U.S. 6,141,831).

With respect to claim 1, Constien discloses a portable information terminal device (Abstract). Constien discloses a first housing, element number 2, and a second housing, element number 1, and a hinge section, element number 8, that connects the two housings (Column 6, lines 7-21). Constien also discloses that the first housing is coupled to the second housing in an openable and closeable

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fashion by the hinge section, and a first function operable when the first housing and the second housing are in an opened state and a second function operable when the first housing and the second housing are in a closed state is selectively used (Column 6, lines 7-21). Constien does not disclose the hinge section's details as recited in the claim.

However, Novin et al. disclose a portable information terminal that connects two housings with a hinge section thus making it analogous art since it is in the same field of endeavor. Novin et al. teaches a first housing, element number 14, having a cutout part formed by cutting out one of the side parts of the first housing as shown in figure 3. Novin et al. also teach hinge section, element number 10, that connects the first housing to a second housing, element number 12. Novin et al. teaches a first hinge part formed on the cutout part as shown in figure 3. Constien further teaches a second hinge part protruded from a side edge of one of the side parts of an inner surface of the second housing toward an inner surface of the first housing in a state that the inner surface of the second housing is opposed to the first housing, wherein the second hinge part has a flat face and is rotatably fit to the first hinge part in the cutout part of the first housing in a state that the second hinge part is flush with the inner surface of the first housing as shown in figures 1-3 (Column 4, lines 30-40).

Therefore, it would be obvious to one of ordinary skill in the art at the time of the applicant's invention to use the hinge construction as taught by Novin et al. in the portable information terminal of Constien in order to provide a hinge that maintains "an open position and a closed position" (abstract).

With respect to claim 2, Constien further discloses an antenna, element number 9, that is housed in the hinge section in a state that the antenna is enabled to be put in and out of the hinge section (Column 6, lines 21-26). According to figure 2, the antenna is slanted in a direction in which the antenna becomes distant from the outer surface of the first housing, and when the second housing is opened with respect to the first housing with the antenna being housed therein, the antenna is projected to have such a length that a tip end of the antenna is away from an upper surface of a work surface on which the first housing is placed.

With respect to claim 3, display window, element number 13, for displaying information is provided on the inner surface of the second housing, and a keyboard, element number 14, is provided on the inner surface of the first housing (Column 6, lines 28-35).

With respect to claims 4-7, Novin et al. further teaches the hinge section including locking means/self closing means (Column 4, lines 30-40). Therefore, it would be obvious to one of ordinary skill in the art at the time of the applicant's invention to use the hinge construction as taught by Novin et al. in the modified portable information terminal of Constien and Novin et al. in order to provide a hinge that maintains "an open position and a closed position" (abstract).

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12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Constien (U.S. 6,259,932) and Novin et al. (U.S. 6,141,831) further in view of Boesen (U.S. 6,892,082).

With respect to claim 8, the modified portable information terminal of Constien and Novin et al. is described above in the discussion of claim 1. Neither Constien nor Novin et al. disclose an insertion hole for a strap. However, Boesen discloses a portable information terminal with dual operating states. Boesen teaches an insertion hole for a strap being formed on a side surface a first housing in figure 3 (Column 3, lines 44-48). Therefore, it would be obvious to one of ordinary skill in the art at the time of the applicant's invention to use strap as taught by Boesen in the modified portable information terminal of Constien and Novin et al. in order to provide a handle for the user.

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Constien (U.S. 6,259,932) and Novin et al. (U.S. 6,141,831) further in view of Terbrack (U.S. 5,398,896).

With respect to claim 9, the modified portable information terminal of Constien and Novin et al. is described above in the discussion of claim 1. Neither Constien nor Novin et al. disclose an elastic member. However, Terbrack discloses an elastic member, element number 46, being in contact with

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an upper surface of a work surface on which a housing is placed (Column 5, lines 60-65). Therefore, it would be obvious to one of ordinary skill in the art at the time of the applicant's invention to an elastic member as taught by Terbrack in the modified portable information terminal of Constien and Novin et al. in order to prevent damaging or scratching the portable information terminal.

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable Tyneski et al. (U.S. 5,584,054) in view of Constien (U.S. 6,259,932).

With respect to claim 14, the portable information terminal of Tyneski et al. is described above in the discussion of claim 10. Tyneski et al. does not disclose the antenna being housed in the hinge section. However, Constien discloses a portable information terminal with two housings being connected with a hinge section. Constien further discloses an antenna, element number 9, is housed in the hinge section in a state that the antenna is enabled to be put in and out of the hinge section (Column 6, lines 21-26). Therefore, it would be obvious to one of ordinary skill in the art at the time of the applicant's invention to include the antenna in the hinge as taught by Constien in the portable information terminal of Tyneski et al. in order to provide a better antenna arrangement for both open and closed states.

15. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Constien (U.S. 6,259,932) in view of Rabe (U.S. 5,832,079).

With respect to claim 18, Constien discloses a portable information terminal device (Abstract). Constien discloses a first housing, element number 2, and a second housing, element number 1, and a hinge section, element number 8, that connects the two housings (Column 6, lines 7-21). Constien also discloses that the first housing is coupled to the second housing in an openable and closeable fashion by the hinge section, and a first function operable when the first housing and the second housing are in an opened state and a second function operable when the first housing and the second housing are in a closed state is selectively used (Column 6, lines 7-21). Constien further discloses first operation section for a function as an information terminal is provided in an inner surface of the first housing and a second operation section for the function as a phone (Column 6, lines 36-65). Constien's portable information terminal includes a first display section 13 for both a function as a phone and the function as an information terminal is provided in an inner surface of the second housing (Column 6, lines 28-35). Constien's portable information terminal also includes a second display 4 for the function as a phone in an outer surface of the second housing (Column 6, lines 7-21). Constien does not disclose the hinge section's details as recited in the claim.

However, Rabe discloses a portable information terminal that connects two housings with a hinge section thus making it analogous art since it is in the same field of endeavor. Rabe teaches a first housing, element number 12, having a cutout part formed by cutting out one of the side parts of the first

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housing as shown in figure 1. Rabe also teaches hinge section that connects the first housing to a second housing, element number 16. Rabe teaches a first hinge part formed on the cutout part, where the pins 34 and 38 fit into in element number 12 of figure 3. Constien further teaches a second hinge part, element numbers 34 and 38, protruded from a side edge of one of the side parts of an inner surface of the second housing toward an inner surface of the first housing in a state that the inner surface of the second housing is opposed to the first housing, wherein the second hinge part is rotatably fit to the first hinge part in the cutout part of the first housing in a state that the second hinge part is flush with the inner surface of the first housing as shown in figures 1-3 (Column 3, line 66 – Column 4, line 24).

Therefore, it would be obvious to one of ordinary skill in the art at the time of the applicant's invention to use the hinge construction as taught by Rabe in the portable information terminal of Constien in order to provide to better mechanical protection for the portable information terminal.

With respect to claim 19, Constien discloses a portable information terminal device (Abstract). Constien discloses a first housing, element number 2, and a second housing, element number 1, and a hinge section, element number 8, that connects the two housings (Column 6, lines 7-21). Constien also discloses that the first housing is coupled to the second housing in an openable and closeable fashion by the hinge section, and a first function operable when the first housing and the second housing are in an opened state and a second

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function operable when the first housing and the second housing are in a closed state is selectively used (Column 6, lines 7-21). Constien shows the keyboard, element number 14, as dent on an inner surface of the first housing, which is the first operation section for a function as an information terminal (Column 6, lines 24-27 and Column 6, lines 28-35). Constien also shows that both of an inner surface and an outer surface of the second housing almost commensurate an area of the dent of the first housing in figures 1 and 2. Constien's portable information terminal includes a first display section 13 for both a function as a phone and the function as an information terminal is provided in an inner surface of the second housing (Column 6, lines 28-35). Constien's portable information terminal also includes a second display 4 for the function as a phone in an outer surface of the second housing (Column 6, lines 7-21). Constien does not disclose the hinge section's details as recited in the claim.

However, Rabe discloses a portable information terminal that connects two housings with a hinge section thus making it analogous art since it is in the same field of endeavor. Rabe teaches a first housing, element number 12, having a cutout part formed by cutting out one of the side parts of the first housing as shown in figure 1. Rabe also teaches hinge section that connects the first housing to a second housing, element number 16. Rabe teaches a first hinge part formed on the cutout part, where the pins 34 and 38 fit into in element number 12 of figure 3. Constien further teaches a second hinge part, element numbers 34 and 38, protruded from a side edge of one of the side parts of an inner surface of the second housing toward an inner surface of the first housing

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in a state that the inner surface of the second housing is opposed to the first housing, wherein the second hinge part is rotatably fit to the first hinge part in the cutout part of the first housing in a state that the second hinge part is flush with the inner surface of the first housing as shown in figures 1-3 (Column 3, line 66 – Column 4, line 24).

Therefore, it would be obvious to one of ordinary skill in the art at the time of the applicant's invention to use the hinge construction as taught by Rabe in the portable information terminal of Constien in order to provide to better mechanical protection for the portable information terminal.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adeel Haroon whose telephone number is (571) 272-7405. The examiner can normally be reached on Monday thru Friday, 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on (571) 272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AH
7/17/06

Nguyen Vo
7-19-2006

NGUYEN T. VO
PRIMARY EXAMINER